

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPELLANTS' REPLY BRIEF

MS Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir,

This Reply Brief is filed in response to the Examiner's Answer issued June 1, 2009.

Since August 1, 2009 falls on a Saturday, Reply Brief is due no later than Monday, August 3, 2009.

Appellants rely upon the arguments made in the Appeal Brief filed January 15, 2009 and respond to the new positions taken by the Examiner in the Examiner's Answer.

Another Change In The Examiner's Position

As explained at page 5 of the Appeal Brief, the Examiner has constantly shifted the factual basis of the pending rejection as well as his explanation of the reasons in support of the rejection. The statement of the rejection at pages 3-7 of the Examiner's Answer appears to be a verbatim copy of the statement of the rejection as it appears in the Final Rejection of May 1.

2008. While the Examiner shifted the basis of the rejection in Advisory Action, he did not change the statement of the rejection in the Examiner's Answer. In addition, the Examiner makes additional findings of fact in the Examiner's Answer for the first time in this case, again without changing the statement of the rejection.

The Examiner explains at page 7 of the Examiner's Answer "the Examiner would like to clarify that the motivations were provided to further justify the combination of Funato, Kallin, and Ho and not to change any position taken." It has long been held that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." . *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) The reasoning used by the Examiner in support of an obviousness rejection is part of the "position taken" by the Examiner. Any statement by an Examiner to "justify" a combination of references is also part of the "position taken" by the Examiner. The statement by the Examiner falls by the force of its own weight and serves to underscore the factual and legal errors made by the Examiner.

In view of the ever shifting position of the Examiner, the Board should review the adverse determination of the Examiner in this case on the specific facts and reasons set forth in the statement of rejection as it appears in the Examiner's Answer.

Claim Construction

The Examiner addresses the claim construction set forth at page 7 of the Appeal Brief stating:

The Examiner respectfully disagrees that the paging is linked to "receiving registration from the mobile station". In defining paging, the claim limitations state that the target MS is paged at a paging area that is centered at a cell in which the target MS **last registered** (**emphasis added**) and does not make mention of receiving any registration from the MS

for performing this function. There is no linking between paging and receiving a registration in the claim language.

Examiner's Answer, pages 8-9.

The Examiner has misconstrued the cited portion of the Appeal Brief and as a consequence has misconstrued the claims. This portion of the Appeal Brief states:

The claims under review are directed to, *inter alia*, a method, computer-readable medium, apparatus, or base station controller for receiving information destined for the target mobile station, paging a target mobile station in a paging area that is centered at a cell, and receiving registration from the mobile station. Registration is received from a mobile station (MS) when a number of cells in a first list is equal to a predetermined number. As part of the registration, the MS will move the cells identified in the first list, other than a cell in which the MS last registered, to a second list. Specification, [0064].

As is apparent, Appellants' statement in the Appeal Brief did not "link" paging and "receiving a registration" as asserted by the Examiner. Rather, the registration is received from the mobile station when a number of cells in a first list is equal to a predetermined number. As set forth in the claims the mobile station will, as part of the registration, move the cells identified in the first list, other than a cell in which the MS last registered, to a second list.

The misreading of the claim language is another example of the factual and legal error made by the Examiner.

**Moving The Cells Identified In The First List, Other Than A Cell In Which The MS
Last Registered, To A Second List**

As mentioned in the opening, Appellants rely upon all of the arguments made in the Appeal Brief. For the purposes of this Reply Brief it is believed helpful to focus on this claim feature as the Examiner has struggled throughout the prosecution of this application to account for this claim feature. The Examiner agrees that neither Kallin, Ho nor Funato describe this feature. The three applied references treat identified cell locations in three completely different manners as follows:

Kallin	Ho	Funato
Stores only the last cell location where the mobile terminal was located. <i>See, e.g.</i> , column 9, lines 11-25; Fig. 2.	After a threshold value is reached, “all cell IDs are removed from the movement history register except for the cell ID of the current cell.” Co. 6, line 49-col. 7 line 26.	Ho uses a previous location table (PLT) and a current location table (CLT). When the mobile handset moves to another paging area in Funato, the CLT is moved to the PLT. Funato, [0088].

Viewing the three references together, it is readily seen that absent knowledge of the present disclosure, there is no reason to combine the three references in the manner needed to arrive at the claimed subject matter as a whole.

New “Motivations” To Combine

The Examiner provides yet another “motivation” to combine the references at page 10 of the Examiner's Answer, stating “Kallin, Ho, and Funato are examples of this relation in that all three inventions pertain to monitoring or tracking the location of a mobile terminal and are therefore combinable.” While the three references are directed to a common problem, that fact

does not lead to a logical conclusion that any *specific teaching* in any one of the references is combinable with any *specific teaching* of another. It is equally logical that the specific teachings of the references are not combinable. As is apparent, any conclusion regarding “combinability” of teachings in references must be based upon specific teachings, not broad goals, and must take into account each reference as a whole.

Again, this statement illustrates the factual and legal errors made by the Examiner in maintaining the pending rejections.

Another new “motivation” to combine the references is set forth at page 11 of the Examiner’s Answer where the Examiner stated:

In the combination of Kallin and Ho, the mobile terminal is further modified to maintain the cell IDS of the movement history in a previous location table to conserve battery power dissipated by the mobile terminal and minimize paging costs by reducing location updates when the mobile terminal moves back to a previously visited cell. Evidence for this motivation is found in Funato in paragraphs 4 and 11.

Paragraphs [0004] and [0011] of Funato only set forth the broad goals of reducing power consumption in mobile devices and paging costs in mobile systems. While it cannot be gainsaid that these are goals in the wireless telecommunication industry, these goals do not provide “motivation” to combine the three very specific and disparate ways Kallin, Ho and Funato seek to achieve these broad goals in the manner needed to arrive at the subject matter set forth in the claims on appeal. The broad brush assertions by the Examiner do not take into account the specific teachings of the three references and further evidence the factual and legal errors in the rejections.

The Examiner Admits That Neither Ho Nor Funato Teach Moving Cells Identified In A First List To A Second List Other Than A Cell That The MS Last Registered

An error in the Examiner's rejection is exemplified in the last paragraph of page 11 of the Examiner's Answer where the Examiner applies certain teachings of the references to certain of the claim language. The Examiner concludes:

Ho teaches maintaining the cell for which the MS last registered in the first list but is silent to what happens to the removed cell IDS in item 614. Funato pertains to maintaining a current location table and a history location table. Funato teaches that when a mobile terminal moves from one paging area, information from a current location table is moved to a previous location table, thus broadly teaching maintenance of current information and previous information in two distinguished tables and moving the current information to a previous information table when an update occurs. Thus in the combination of the inventions, the current cell ID would be maintained as taught by Ho and the removed cell IDS would be moved to a previous location table or second list as taught by Funato.

The Examiner presumes in this statement that there is a rational reason for combining Ho and Funato. The broad "motivations" of saving battery power and conserving paging resources of the network do not provide such "motivation." The Examiner has surgically excised certain portions of the references that he believes support his position and ignores the references as a whole. This is error on the part of the Examiner.

Conclusion

For the reasons set forth in the Appeal Brief and above, it is believed the Examiner's rejections are in error and should be reversed.

Respectfully submitted,

Dated: July 31, 2009

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